



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/827,788

04/09/2001

Khai Hee Kwan

8886

23336

7590

07/14/2006

KHAI HEE KWAN  
315 AVOCA ST.  
RANDWICK, 02031  
AUSTRALIA

EXAMINER

HAQ, NAEEM U

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/827,788

Applicant(s)

KWAN, KHAI HEE

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33,34,37,38,40,41,44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33,34,37,38,40,41,44 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2006 has been entered.

### ***Election/Restrictions***

Applicant's election with traverse of Group II (claims 33, 34, 37, 38, 40, 41, 44, and 45) in the reply filed on April 19, 2006 is acknowledged. The traversal is on the ground(s) that there is no reasoning on the record that the field of search between the two groups is different or that it would be unreasonably burdensome for the examiner to do so. This is not found persuasive because the invention of Group I has two distinct networks which are not present in the elected claims. Thus the search for Group I requires additional searching above and beyond that required for the elected claims. The Examiner finds this additional searching to be burdensome because it requires a different search strategy from the one required for the elected claims. A similar analysis applies to the species of Group II.

The requirement is still deemed proper and is therefore made FINAL.

**Specification**

The amendment filed February 25, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Referring to claims 33 and 40:

*"payment processor receiving at least the payer's account identifier, the transfer amount, the payee's account identifier upon initiation of a transaction over a first network from payer"*

*"payment processor transmitting said payer's account identifier, password and said amount to payer's telecommunication carrier provider for authentication"*

*"payment processor transmitting said payee's account identifier to payee's telecommunication carrier provider for authentication"*

*"whereby said payment processor is a single point of contact to process transactions between payer and payee..."*

Applicant is required to cancel the new matter in the reply to this Office Action.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33, 34, 37, 38, 40, 41, 44, and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

Art Unit: 3625

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims 33 and 40: This claim recites limitations, which lack written description support in the original application, as follows:

*"payment processor receiving at least the payer's account identifier, the transfer amount, the payee's account identifier upon initiation of a transaction over a first network from payer"*

*"payment processor transmitting said payer's account identifier, password and said amount to payer's telecommunication carrier provider for authentication"*

*"payment processor transmitting said payee's account identifier to payee's telecommunication carrier provider for authentication"*

*"whereby said payment processor is a single point of contact to process transactions between payer and payee..."*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33, 34, 37, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "the networks" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 33, 34, 37, 38, 40, 41, 44, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrill, Jr. (US 5,991,749) (“Morrill”).**

Referring to claim 33: Morrill discloses a computer readable storage medium storing instructions that, when executed by a computer to perform a method for payment or fund transfer transactions, the method comprising:

- providing at least a centralized payment processor linked to the networks connecting to at least a telecommunication carrier provider's server having telecommunication accounts and corresponding account identifiers (col. 2, lines 19-32);
- providing a wireless communication device (col. 1, lines 14-17; col. 2, lines 19-32);
- payment processor receiving at least the payer's account identifier (col. 2, lines 50-55), the transfer amount (col. 2, lines 45-49), the payee's account identifier upon initiation of a transaction over a first network from payer (col. 2, line 63 – col. 3, line 5);
- payment processor receiving at least a password from payer (col. 2, lines 60-63);

- payment processor transmitting said payer's account identifier, password and said amount to payer's telecommunication carrier provider for authentication (col. 3, lines 20-35);
- payment processor transmitting said payee's account identifier to payee's telecommunication carrier provider for authentication (col. 3, lines 20-35; col. 5, lines 29-35);
- payment processor receiving approval or rejection from authentication process from respective said carrier providers of payer and payee (col. 3, lines (col. 3, lines 20-35);
- whereby said both authentication are approved, includes a further step of payment processor transmitting to payer's said carrier provider to record a debit entry for said transfer amount in payer's account and transmitting to payee's said carrier provider to record a credit entry for same for payee's account (col. 3, lines 20-35; col. 5, lines 29-35); and
- whereby said payment processor is a single point of contact to process transactions between payer and payee having accounts with different telecommunication carrier providers (col. 4, lines 41-44; col. 5, lines 29-35).

Referring to claim 34: Morrill teaches all the limitations of claim 33 as noted above. Furthermore, Morrill teaches the payment processor is coupled to at least one of the telecommunication service provider's server (col. 2, lines 29-59).

Art Unit: 3625

Referring to claim 37: Morrill teaches all the limitations of claim 33 as noted above. Furthermore, Morrill teaches that after the authentication is approved the step of: the payer's wireless communication device receiving at least one of the following: a receipt evidencing said transfer (col. 4, lines 48-64; col. 5, lines 36-60).

Referring to claim 38: Morrill teaches all the limitations of claim 37 as noted above. Furthermore, Morrill teaches where the payee is a merchant (col. 4, lines 39-47), providing on-site point of sale terminal (col. 4, lines 44-47), receiving said receipt from said payer's wireless communication device to said terminal for verification (col. 5, lines 50-59), if verified then receiving physical goods from said merchant (col. 4, lines 39-64).

Referring to claim 40: Claim 40 is rejected under the same rationale as set forth above in claim 33.

Referring to claim 41: Claim 41 is rejected under the same rationale as set forth above in claim 34.

Referring to claim 44: Claim 44 is rejected under the same rationale as set forth above in claim 37.

Referring to claim 45: Claim 45 is rejected under the same rationale as set forth above in claim 38.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Naeem Haq', with a stylized flourish at the end.

**Naeem Haq**, Patent Examiner  
Art Unit 3625

July 6, 2006